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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,924

03/08/2005

Johannes Marra

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER

REHM, ADAM C

ART UNIT

PAPER NUMBER

2885

MAIL DATE

DELIVERY MODE

02/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/526,924

Applicant(s)

MARRA ET AL.

Examiner

Adam C. Rehm

Art Unit

2885

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive. Applicant asserts the following:

- (1) Regarding the "free-flowing powder", Applicant asserts the claimed invention is distinguishable from MOBE since MOBE discloses a free flowing powder that is not free flowing after manufacture. However, Examiner notes that Applicant's claim language does not distinctly claim that the free-flowing powder retains its free flowing nature after manufacture. Thus, it is reasonable to assert that Applicant claims a free-flowing powder that is set in a varnish, which is commensurate with MOBE. While limitations present in the specification are not read into the claims, Examiner concurs with Applicant's argument that there is support in the specification to amend the claims to indicate the free-flowing nature of the powder after manufacture. However, there may be a 112 enablement issue given that it is not clear how the free-flowing particles retain an effective position as opposed to falling to the bottom of the enclosure.
- (2) Applicant appears to argue that ONO does not teach every single compound in Applicant's list present in Claim 2. Notably, Applicant claims the compounds in the alternative. Thus, ONO need only teach a single compound, which it does, i.e. Al₂O₃.
- (3) Applicant argues that ONO does not teach Al₂O₃ particles mixed with one of the compounds of Claim 2. Examiner notes that one of the compounds is Al₂O₃ and basis the rejection on the fact that Al₂O₃ particles are inevitably mixed with other Al₂O₃ particles upon manufacture.
- (4) Applicant argues that changing the size of the reflective particles in order to change the reflective properties of the reflective particles is not a result effective variable, but the result of inventive effort. However, it is notoriously known that a larger reflector will reflect more light than a smaller reflector. As such, changing the size of the reflector will result in a different variable that is dependent on the change in size. Thus, it is Examiner's position that since the prior art discloses reflective particles, merely claiming a specific particle size in order to obtain the obvious result is the work of a skilled mechanic and not that of an inventor. In re Boesch, 205 USPQ 215.



THOMAS M. SEMBER
PRIMARY EXAMINER